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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,230	12/03/2001	Takeshi Utsunomiya	35.G2946	5081

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EXAMINER

DIVINE, LUCAS

ART UNIT PAPER NUMBER

2624

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/998,230	Applicant(s) UTSUNOMIYA, TAKESHI	
	Examiner Lucas Divine	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 19 – 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The program product claimed is merely a set of instructions per se that is on a product, which could range from a piece of paper or instructions imprinted on the side of a wall. Since the program product is merely a set of instructions not embodied on a computer readable medium to realize the computer program functionality, the claimed subject matter is non-statutory. See MPEP § 2106.
3. Claims 28 – 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite a medium, which could range from a piece of paper or instructions imprinted on the side of a wall, storing a computer program. In order to be statutory, the claim must recite a computer program embodied on a computer readable medium. Simply storing a program on a medium does not make a claim statutory, and further the claim only stores the product, which does not indicate that the program is executable as stored. See MPEP § 2106.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 5, 7, 10, 11, 13, 16, 19, 20, 23, 25, 28, 29, 32, and 34 are rejected under 35

U.S.C. 102(e) as being anticipated by Iga (US 2002/0143924).

Regarding claim 1, Iga teaches **a printer** (10, Figs. 1B-1C) **comprising:**

**a setting unit** (Control Instruction Execution Unit 40 [Fig. 1B and its description] acts as a setting unit by executing the commands in the email [commands shown in Figs. 11 – 15 and shown in many other figures]) **adapted to set a mode of printing** (Fig. 6F, Tiff emulation mode, Pcl emulation mode, etcetera) **based on a command included within a received electronic mail** (print settings can be controlled through email commands, Fig. 14 as example); **and**

**a printing unit** (Printer Engine 24 [Fig. 1C and its description]) **adapted to print the received electronic mail** (Fig. 7B, step S12; Fig. 10; Fig. 14) **in the mode of printing set by said setting unit** (Fig. 14 for example of a Tiff emulation mode and Figs. 15).

Regarding claim 2, which depends from claim 1, Iga further teaches **printing an attached file of the received email** (Fig. 14 and paragraph 37).

Regarding claim 5, which depends from claim 1, Iga teaches **setting unit sets a format** (the output format is set by unit 40 in order to correctly emulate and convert the given format into bitmap data [see Fig. 6F and its discussion in paragraph 43]).

Regarding claim 7, which depends from claim 1, Iga teaches **correlation of a password of the received electronic mail is performed** (the figures show password information [abc111] in the email, paragraph 41, wherein a password 110 for security is set; paragraph 44; Fig. 7A step S5), **and, when the password is a correct password** (Fig. 7A, step S5), **setting by said setting unit and printing by said printing unit are executed** (Fig. 7A, step S6, wherein the command sent in the email is executed if the password is correct).

Regarding claims 10, 11, 14, 16, 19, 20, 23, 25, 28, 29, 32, and 34, the structural elements of apparatus claims 1, 2, 5, and 7 perform all of the method and code steps of these claims. Further Iga teaches in paragraph 1 that the invention can be implemented as a method or program. Thus, these method and code claims are rejected for the same reasons as stated in the rejection of the apparatus claims.

5. Claims 8, 9, 17, 18, 26, 27, 35, and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Haines et al. (US 6295423).

Regarding claims 8 and 9, Haines teaches **a printer (10) comprising:**  
**a setting unit** (warning generator 35, Fig. 3) **adapted to set information for transmitting a mail to a destination** (step 122 of Fig. 5; col. 7 line 43) **corresponding to a**

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**change in a state** (step 120 Fig. 5 – which is also a **trigger condition** set for a user [user is associated with email address in order for the email to be transmitted to that user, user setting shown in Fig. 4 and its description]); **and**

**a transmission unit** (processor 36 controls the printer 10) **adapted to transmit the mail** (transmitted to user in col. 7 lines 41-43) **when the state has changed, based on the information set by said setting unit** (col. 7 lines 33-45).

Regarding claims 17, 18, 26, 27, 35, and 36, the structural elements of claims 8 and 9 perform all of the method and code steps of these claims. Further, the system is a computing system with memory 38 and processor 36 for encoding and executing the code. Therefore, Haines anticipates these claims and they are rejected for the same reasons set forth in the rejection of apparatus claims 8 and 9.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4, 13, 22, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iga as applied to claims 1, 10, 19, and 28 above, and further in view of Tomiyasu (US 6590675).

Regarding claim 4, which depends from claim 1, while Iga teaches the control of printers remotely through commands set forth in emails, including control over printing operations, Iga does not specifically teach **setting an overlay function** of the printing operation.

However, Tomiyasu teaches overlay instructions/commands for setting a printer to perform an overlay function (Figs. 6A, 6B, 9 are all examples of overlay command control for controlling a printer to perform an overlay function – overlay instructions further discussed in the abstract and summary of the invention). Further, the print apparatus 7 of Tomiyasu is similar to that of Iga in that it has a command analyzer 9 (setting unit) and a print engine 11 (printing unit) as shown in Fig. 1. Tomiyasu shows that overlay functions were well known printing operations and Iga teaches that the commands are for control of the printing device.

It would have been obvious to one of ordinary skill in the art that the emails of Iga could include overlay commands for setting overlay functions instead of requiring a local computer of Tomiyasu. The motivation for doing so would have been to allow a remote user to manage and control the printer (see 0002 of Iga for explanation of benefits of remote printer management).

Regarding claims 13, 22, and 31, the structural elements of apparatus claim 4 perform all of the method and code steps of these claims. Further Iga teaches in paragraph 1 that the invention can be implemented as a method or program. Thus, these method and code claims are rejected for the same reasons as stated in the rejection of the apparatus claims.

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7. Claims 3, 6, 12, 15, 21, 24, 30, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iga as applied to claims 1, 10, 19, and 28 above, and further in view of well known prior art.

Regarding claim 3, which depends from claim 1, while Iga teaches the control of printers remotely through commands set forth in emails, including control over printing operations (paragraph 0003, 0004, 0008 and throughout), Iga does not specifically teach setting **number of copies, duplex printing, sorting, stapling, and a number of pages to be printed on a single sheet**.

However, Examiner takes Official Notice that these print settings are well known in the prior art as standard print settings that a user would like to set when printing.

It would have been obvious to one of ordinary skill in the art that the emails of Iga could include print setting commands for setting various print attributes for the final output instead of requiring a local computer to set them or requiring them to be set at the printer itself. The motivation for doing so would have been to allow a remote user to manage and control the printer (see 0002 of Iga for explanation of benefits of remote printer management).

Regarding claim 6, which depends from claim 51, while Iga teaches the control of printers remotely through commands set forth in emails, including control over printing operations (paragraph 0003, 0004, 0008 and throughout), Iga does not specifically teach setting **size of characters, character spacing, line spacing, sheet size, or assignment of a sheet tray**.

However, Examiner takes Official Notice that these print format settings are well known in the prior art as standard print format settings that a user would like to set when printing.



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It would have been obvious to one of ordinary skill in the art that the emails of Iga could include print format setting commands for setting various print control attributes for the final output instead of requiring a local computer to set them or requiring them to be set at the printer itself. The motivation for doing so would have been to allow a remote user to manage and control the printer (see 0002 of Iga for explanation of benefits of remote printer management).

Regarding claims 12, 15, 21, 24, 30, and 33, the structural elements of apparatus claims 3 and 6 perform all of the method and code steps of these claims. Further Iga teaches in paragraph 1 that the invention can be implemented as a method or program. Thus, these method and code claims are rejected for the same reasons as stated in the rejection of the apparatus claims.

### *Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine  
Examiner  
Art Unit 2624

ljd



**KING Y. POON**  
**PRIMARY EXAMINER**